

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-17 are presently active; Claims 1-10 having been amended, and Claims 11-17 having been added by the present amendment. Claims 1-10 have been amended solely to better conform to standard U.S. practice (e.g., by removal of reference numbers); thus, Applicants submit that the scope of these claims has not been narrowed.<sup>1</sup> Support for new Claims 11-17 can be found at least in the subject matter of Claims 1-10 as originally filed; from page 6, line 3, to page 11, line 29, of Applicants' specification; and in Applicants' Figure 1. Also, the paragraph beginning at page 10, line 17, of Applicants' specification has been amended solely to correct a typographical error. No new matter has been added by the present amendment.

In the Office Action, Claim 10 was objected to as being a multiple depending claim depending from another multiple depending claim. Claims 1-9 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 2, 4, 6, 7, 9-from-6, and 9-from-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over International Publication No. WO 98/34203 (hereinafter "WO '203") in view of International Publication No. WO 98/37524 (hereinafter "WO '524"). Claims 3, 8, and 9 depending from 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over WO '203 in view of WO '524 in view of Official Notice. Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over WO '203 in view of WO '524 as applied to claim 1, and further in view of Maes et al. (U.S. Patent No. 6,016,476).

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<sup>1</sup> This comment is made in view of the recent Festo decision which limits the applicability of the Doctrine of Equivalents for amendments relating to patentability reasons.

Regarding the objection to Claim 10, this claim has been amended to remove multiple dependency language. Accordingly, Applicants respectfully request reconsideration and withdrawal of this objection.

Regarding the rejection of Claims 1-9 under 35 U.S.C. §112, second paragraph, Applicants submit that the foregoing amendment properly addresses the concerns set forth in numbered section 4 of the Office Action. Specifically, Claims 1 and 6 have both been amended to recite “a service point identification, the payment terminal identification, and the total transaction amount” (emphasis added). Further, Claim 1 has been amended to recite “a first contactless device interface” and “a second contactless device interface.” Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Regarding the rejection of Claims 1, 2, 4, 6, 7, and 9, Applicants respectfully submit that the suggested combination of WO ‘203 and WO ‘524 fails to teach or suggest Applicants’ claimed combinations. For example, amended Claim 1 recites, among other features:

...the payment terminal...adds a payment terminal identification to the transaction identification, the payment terminal identification identifying the respective payment terminal from a plurality of payment terminals existing at the service point,

the mobile device transmits, via a first contactless device interface, the transaction identification entered by the customer to the payment terminal identified by the payment terminal identification,

the payment terminal, after receipt of the transaction identification, transmits a payment request...via a second contactless device interface to the mobile device, and

a payment record is prepared in the mobile device, the payment record...being transmitted from the mobile device via the contactless device interface to the payment terminal.<sup>2</sup>

Thus, in accordance with the claimed method of amended Claim 1, a payment request is sent from a payment terminal to a mobile device *after* the payment terminal receives a transaction

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<sup>2</sup> Specification at amended Claim 1.

identification from the mobile device.<sup>3</sup> A payment record is then prepared and transmitted from the mobile device to the payment terminal based on the received payment request.<sup>4</sup> To ensure that a payment transaction is performed between the mobile device and a particular payment terminal, the transaction identification includes a payment terminal identification identifying the payment terminal from a plurality of payment terminals located at the service point.<sup>5</sup> In this way, at least three transmissions between a mobile device and a payment terminal are performed to ensure an accurate and efficient payment transaction.

In contrast to amended Claim 1, WO '203 discloses a method for performing financial transactions that includes only two transmissions between a customer mobile unit and a merchant cashier unit.<sup>6</sup> In the first transmission, a merchant cashier unit transmits data to a customer mobile unit,<sup>7</sup> where the data include transaction information and a request for authorization.<sup>8</sup> In the second transmission, the customer mobile unit transmits financial ID and authorization to the merchant cashier unit.<sup>9</sup>

WO '203 does not disclose a mobile device transmitting transaction identification to a payment terminal. More particularly, WO '203 does not disclose making such a transmission before a payment request is sent to the mobile device from the payment terminal. Further, WO '203 does not disclose any transaction identification including a payment terminal identification. Such deficiencies with regards to amended Claim 1 are readily understandable, as the method disclosed in WO '203 involves a transaction where, referring to Figure 8 of WO '203, the cashier register 414 and the mobile unit 412<sup>10</sup> are the only devices available for performing a transaction. For example, because the mobile unit 412 can

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<sup>3</sup> E.g., see Specification from page 9, line 9, to page 10, line 16; and at Figure 1 (arrows S1 and S2).

<sup>4</sup> E.g., see *Id.* at page 11, lines 5-21.

<sup>5</sup> E.g., see *Id.* at page 7, lines 19-24.

<sup>6</sup> WO '203 at Figure 6.

<sup>7</sup> *Id.* at Figure 8 (cashier register 414 and mobile unit 412).

<sup>8</sup> *Id.* at Figure 6 (step 200).

<sup>9</sup> *Id.* at Figure 6 (step 202).

<sup>10</sup> *Id.* at Figure 8.

only communicate with the cashier register 414, and not with any other cashier registers, the establishment of device identities is unnecessary. As such, WO '203 fails to disclose amended Claim 1.

To remedy the deficiency of WO '203 with regards to the payment terminal identification feature of amended Claim 1, the Office Action looks to the teachings of WO '524. However, WO '524 neither remedies this deficiency nor the other above-discussed deficiencies of WO '203 with regards to amended Claim 1. WO '524 discloses a transaction method involving a mobile unit 1 and a terminal 2, which is connected to a financial server 4 via a telecommunications network.<sup>11</sup> In a transactional step, the financial server 4 receives a customer identification, a terminal identification, and transaction specific data.<sup>12</sup>

WO '524 discloses the general use of a terminal identification, but does not disclose the transmitting of transaction identification from a mobile device to a payment terminal before a payment request is sent from the payment terminal to the mobile device, where the transaction identification includes a payment terminal identification, as recited in amended Claim 1. Rather, WO '524 simply describes the transmitting of customer identification, terminal identification, and transaction specific data to a financial server. In this way, WO '524 does not appear to be any different from the known methods discussed in the background section of Applicants' specification.<sup>13</sup> As such, WO '524 fails to remedy the deficiencies of WO '203 with respect to amended Claim 1.

For at least the reasons discussed above, Applicants respectfully submit that amended Claim 1 is patentable over WO '203 and WO '524, taken either individually or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal

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<sup>11</sup> WO '524 at Abstract, lines 1-6, and at Figure 1.

<sup>12</sup> *Id.* at Abstract, lines 3-6.

<sup>13</sup> See Specification at page 2, lines 2-8.

of the rejection of Claim 1 under 35 U.S.C. §103(a). Claims 2-5 depend from Claim 1 and are allowable for at least the reasons discussed above.

Amended Claim 6 recites, among other features:

...each of the payment terminals includes a transaction identification module configured to determine the transaction identification for a payment transaction and to add a payment terminal identification for the respective payment terminal to the transaction identification,

each of the mobile devices includes a transaction response module configured to receive a transaction identification...and to transmit the transaction identification via a first contactless device interface to the payment terminal determined through the payment terminal identification contained in the transaction identification,

each of the payment terminals includes a payment request module configured to... transmit a payment request... via a second contactless device interface to the mobile device from which the transaction identification was received, and

each of the mobile devices includes a payment record module configured to prepare a payment record...and to transmit the prepared payment record via the contactless device interface to the payment terminal from which the payment request was received.<sup>14</sup>

As amended Claim 6 recites features similar to those of amended Claim 1 with regards to a transaction identification, a payment terminal identification, and the transmission of a payment request based on the transaction identification, Applicants respectfully submit that amended Claim 6 is also patentable over WO '203 and WO '524, taken either individually or in combination, for at least the reasons discussed above. Claims 7-10 depend from Claim 6 and are also patentable for at least the above-discussed reasons.

New Claim 11 recites method steps corresponding to, among other features, the separate transmissions of a transaction identification, a payment request, and a payment record as discussed above with regards to Claim 1. New Claim 15 recites a system for performing a payment transaction including features also directed to separate transmissions of a transaction identification, a payment request, and a payment record as discussed above

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<sup>14</sup> Specification at amended Claim 6.

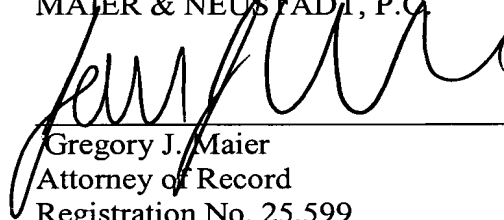
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with regards to Claim 1. Accordingly, Applicants respectfully submit that these new independent claims and their dependent claims are also patentable over the cited documents.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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